UNITED STATES PATENT AND TRADEMARK OFFICE

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10/774,877	02/10/2004	Todd Simpson	87239/00004	8796

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *30 April 2008*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-56* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-56* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to Applicant's amendment filed on 4/30/2008. Claims 14-25,

29, 31-34, 37-47, 52, and 53 are amended. Claims 14-56 are presented for further examination.

2.   This action is a final rejection.

Response to Arguments

3.   The objections to Applicant's specification and the §101 rejections are withdrawn in light

of Applicant's amendment and remarks. Applicant's arguments with respect to the §102(e) and

§103(a) rejections have been considered but are moot in view of the new ground of rejection

necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 14-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention.

Specifically, Applicant has amended the independent claims to recite, *inter alia*, that the negotiation process comprises a sender subsystem associating a category with a message upon receiving an indication that the receiver recognizes the category. Applicant's specification has been carefully reviewed and no written description for this feature was found. There is no explicit disclosure describing that the negotiation process includes the receiver sending an indication that a sender-proposed category is acceptable. There is also no explicit disclosure describing that the sender associates the category with the message *only upon receiving* the indication that the category is recognized by the receiver subsystem (claim 14) or acceptable (claim 47). If Applicant disagrees with this rejection, Applicant should point out the description in the specification that explicitly supports the claimed feature.

The dependent claims are rejected based on their dependency on the deficient independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 14-17, 20, 23, 37-42, and 47-56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schiavone et al, U.S Patent Publication No. 2002|0120600 ["Schiavone"], in view of Gross et al, U.S Patent Publication No. 20040111478 ["Gross"].

6.   As to claim 14, Schiavone discloses an e-mail system for exchanging messages among

users of the system, the system comprising:

a sender subsystem for transmitting a message from a sender to a receiver, the sender

subsystem having access to a list of categories [0062 : Schiavone's mailing software 170 reads

on Applicant's claimed sender subsystem | 0026 : senders "share knowledge of a common set of

message type specifiers" where Schiavone's specifier reads on Applicant's claimed category];

and

a receiver subsystem for receiving the message, the receiver subsystem being in data

communication with the sender subsystem [0064 : the "recipient's communication device 150"

reads on Applicant's claimed receiver subsystem | 0026].

wherein the sender subsystem is configured to identify a category for the message based

on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software

and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to

initiate a negotiation process with the receiver subsystem [0051: negotiating the delivery of the

email messages], to associate the category with the message [0035], and to transmit the

categorized message to the receiver subsystem [0062-0064].

Schiavone does not expressly disclose that the sender subsystem associates the category

with the message *upon receiving an indication from the receiver subsystem that the category is*

recognized by the receiver subsystem. However, such a feature was well known in the art at the

time of Applicant's invention. Gross is directed towards a system in which users identify how

messages are to be processed using categorization techniques [0013]. Gross further discloses a

sender subsystem associating a category with a message upon receiving an indication that a

receiver subsystem recognizes the category [0046: the receiver-approved tags are transmitted to

the sender as the sender composes the message | 0263 : receiver may accept or reject the

proposed category | 0268 : sending an indication to the sender to recategorize a message

according to newly accepted categories].

It would have been obvious to one of ordinary skill in the art to have modified

Schiavone's system for negotiating email transactions to have included Gross' teachings.

Specifically, one would have been motivated to include the feature of enabling a receiver to

either accept or reject sender-proposed categories into Schiavone's negotiations functionality.

Such a feature improves Schiavone's system because in allowing a receiver to restrict the

distribution of the categories, messages may be appropriately categorized and processed

according to the receiver's control [see Gross, 0044].

7.   As to claim 15, Schiavone discloses the recognized category is identical to a receiver

category [0062 : "list of shared specifiers"].

8.   As to claim 16, Schiavone discloses the recognized category is mapped from a receiver

category [0062 : negotiated specifier is selected from the list].

9.   As to claim 17, Schiavone discloses the recognized category is a new category added to a

listing of receiver categories [0025 : Schiavone discloses scanning the text of the message and

creating a new specifier based on the text of the message. Thus, the specifier is newly added.

Also see Gross, 0261].

10.   As to claim 20, Schiavone discloses an intermediary subsystem, wherein the listing of

categories is provided to the sender subsystem through the intermediary subsystem [0026].

11.   As to claim 23, Schiavone discloses a user interface for presenting the listing of

categories to the sender subsystem to select the category therefrom [0025 : specify a mail type

specifier by selection from a menu].

12.   As to claims 27 and 28, Schiavone does not discloses the category belonging to one of

the two listings and is mapped or is a new category to a second category belonging to the other

of the two listings. However, such as feature was well known in the art at the time of Applicant's

invention. For example, Gross discloses the feature. Specifically, Gross discloses selecting a

category from a receiver listing and mapping it (of adding a new category) to a sender listing and

allowing the sender to use the category specified by the receiver listing [0010, 0217]. It would

have been obvious to one of ordinary skill in the art to have modified Schiavone's email system

to include Gross' teachings of mapping new categories to a sender. Enabling the receiver to

specify the categories used by the sender gives a receiver more control over the categories that

may be used by the sender.

13.   As to claims 37 and 52, as they do not teach or further define over the limitations of

claim 14, claims 37 and 52 are rejected for at least the same reasons set forth for claim 14.

14.   As to claim 38, as it does not teach or further define over the limitations of claim 15,

claim 38 is rejected for at least the same reasons set forth for claim 15.

15.   As to claims 39 and 54, as they do not teach or further define over the limitations of

claim 23, claims 39 and 54 are rejected for at least the same reasons set forth for claim 23.

16.   As to claim 40, as it does not teach or further define over the limitations of claim 16,

claim 40 is rejected for at least the same reasons set forth for claim 16.

17.   As to claims 41 and 53, as they do not teach or further define over the limitations of

claims 16 and 17, claims 41 and 53 are rejected for at least the same reasons set forth for claims

16 and 17.

18.   As to claim 42, as it does not teach or further define over the limitations of claims 20 and

21, claim 42 is rejected for at least the same reasons set forth for claims 20 and 21.

19.   As to claim 47, Schiavone discloses a method of transmitting a message to a receiver for

a sender in a message exchange system, the sender having a sender subsystem for sending the

message and the receiver having a receiver subsystem for receiving the message, the sender

subsystem having access to a listing of categories recognized by the receiver subsystem [see

rejection of claim 14], the method comprising:

obtaining a destination address from the sender for identifying the receiver [0023 – use of

an the receiver's email address];

receiving information from the sender to be included in the message [0025 – specifier

based on content];

the sender subsystem negotiating a category with the receiver subsystem, the category

being identified by the sender subsystem based on the information and the listing of categories

[0026];

associating the category with the message [0025]; and

transmitting the categorized message to the receiver subsystem, the message being

associated with the category [0024, 0025].

Schiavone does not expressly disclose that the sender subsystem categorizes with the

message *only upon receiving an indication from the receiver subsystem that the category is*

acceptable. However, such a feature was well known in the art at the time of Applicant's

invention. The basis of rejection is the same as the rejection of claim 14.

20.   As to claims 48-51, as they do not teach or further define over the limitations of claims

15-17 and 20, claims 48-51 are rejected for at least the same reasons set forth for claims 15-17

and 20.

21.   As to claims 55 and 56, Schiavone discloses inserting an indication of the category in a

section or header of the message [0024].

22.   Claims 18, 19, and 44-46 are rejected under 35 U.S.C. §103(a) as being unpatentable

over Schiavone and Gross, in view of Schiavone et al, U.S Patent Publication No. 20020120748

["Koenig"].

23.   It should be noted that Koenig describes additional aspects of Schiavone's invention.

Schiavone makes explicit reference to the Koenig application [0068 : "Selective Delivery and

Forwarding of Electronic Mail"]. Therefore, it would have been clear to one of ordinary skill in

the art to have incorporated Koenig and Schiavone together to fully realize Schiavone's

invention.

24.   As to claims 18 and 19, Schiavone does not expressly disclose storing or indexing the

message according to the negotiated category. However, describing an additional aspect of

Schiavone's email system, Koenig discloses using the message specifiers (or identifiers) to store

and index a copy of the categorized email messages in a categorized inbox [0039 : specifiers

including "personal", "business"].

25.   As to claim 44, Schiavone does not expressly disclose storing the categorized message

together with an indication of the category associated therewith. However, Koenig describes this

aspect of Schiavone's invention [0039].

26.   As to claims 45 and 46, as they do not teach or further define over the limitations of

claims 18 and 19, claims 45 and 46 are rejected for at least the same reasons set forth for claims

18 and 19.

27.   Claims 21, 22, 24-26, 29-36, and 43 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Schiavone and Gross.

28.   As to claim 21, Schiavone does not expressly disclose that the listing of categories is a

union of a first listing provided by the intermediary subsystem and a second listing provided by

the sender subsystem. However, Schiavone does disclose that the listing of categories is a result

of shared "knowledge of a common set of message type specifiers" [0026]. The term "common

set" is well known to refer to a set of items in common between two different sets. Thus, it would

have been obvious for one of ordinary skill in the art to have reasonably inferred from

Schiavone's use of the term "common set" that the listing of categories was a result of a union of

message type specifiers provided by the sender and the third party.

29.   As to claim 22, Schiavone does not expressly disclose a sender intermediary subsystem

for communicating with said intermediary subsystem to negotiate said category. However, the

concept of distributing different functionalities between different network elements, such as from

a sender to a sender's intermediary, is well known and obvious. Schiavone does disclose that his

system can be implemented by spreading out different functionalities to multiple third party

intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented Schiavone with a sender intermediary subsystem to perform the sender's responsibilities.

30.   As to claim 24, Schiavone discloses a system for classifying messages transmitted by a message exchange system, the message exchange system including a sending subsystem for transmitting a message from a sender to a receiver and a receiving subsystem for receiving the message, the system comprising:

a negotiation module, the negotiation module maintaining a listing of categories [0064 : Schiavone's trust authority 200 reads on a negotiation module];

wherein the sender subsystem is configured to identify a category for the message based on the listing of categories [0035 | 0062 : receiver sharing knowledge with the mailing software and the mailing software selecting a mail-type specifier based on a list of shared specifiers], to initiate a negotiation process with the receiver subsystem [0051: negotiating the delivery of the email messages], to associate the category with the message [0035], and to transmit the categorized message to the receiver subsystem [0062-0064].

Schiavone does not expressly disclose that the sender subsystem associates the category with the message *upon receiving an indication from the receiver subsystem that the category is recognized by the receiver subsystem.* However, such a feature was well known in the art at the time of Applicant's invention. See the rejection of claim 14.

Schiavone also discloses a sender subsystem for initiating negotiation of a category and a receiver subsystem for providing the sender subsystem with the listing of categories [0026, 0064,

0066] however Schiavone does not expressly disclose that the sender and receiver subsystems are included in the negotiation module. However, the concept of distributing different functionalities between different network elements, such as from a sender to a sender's intermediary, is well known and obvious. Schiavone does disclose that his system can be implemented by spreading out different functionalities to multiple third party intermediaries [0066]. Thus, it would have been obvious to one of ordinary skill in the art to have implemented Schiavone with a sender intermediary subsystem to perform the sender's responsibilities.

31.   As to claim 25, Schiavone discloses said sender subsystem having access to a listing of sender categories and is operative to deduce the category from the listing of categories maintained by the negotiation module and the listing of sender categories [0026, 0062 : "list of shared specifiers" : also see the rejection of claim 21].

32.   As to claim 26, Schiavone discloses the category is a common category belonging to the listing of sender categories and the listing of categories maintained by the negotiation module [0026 : also see the rejection of claim 21].

33.   As to claim 29, Schiavone discloses the message exchange system further includes a plurality of receiving subsystems for receiving the message for a plurality of receivers [0065], said negotiation module further including a plurality of receiver subsystems, each of said plurality of receiver subsystems being operative to provide said sender subsystems with an indication that the category is recognized by each receiver subsystem [0026, 0066 : the recipient

compliance engine as part of the negotiation module | see rejection of claim 14].

34.   As to claim 30, Schiavone discloses establishing a common category for a subset of said

plurality of receivers and to associate said common category with the message for said subset of

receivers [0055].

35.   As to claim 31, Schiavone discloses the use of one or more intermediary subsystems, said

one or more intermediary subsystems having access to at least a separate listing of additional

categories, and wherein the category is identified from a union of said separate listing of

additional categories and the listing of categories [0026 : see rejection of claim 21 with respect to

the concept of a "common set." Adding "additional categories" would have been obvious to one

of ordinary skill in the art because a "common set" can refer to the union of multiple sets of

items].

36.   As to claims 32 and 34, Schiavone discloses one of said one or more intermediary

subsystems is selected by said receiver subsystem or sender subsystem [0030 – selecting a

trusted authority]. Schiavone does not expressly disclose that the subsystems select the authority.

However, such a feature is implied by Schiavone's teaching that the sender and receiver have a

shared common set of specifiers. This teaching implies that the sender and receiver have selected

an intermediary to which to send their set of specifiers.

37.   As to claim 33, Schiavone does not expressly disclose a search module for searching for

an selecting said one or more intermediary subsystems. However, such a feature is implied by

Schiavone's teachings that there can be more than one intermediary subsystem [0066 : trusted

authority and/or another third party]. Since there are multiple intermediaries in Schiavone's

system, it would have been obvious to one of ordinary skill in the art to have reasonably inferred

the use of a method to search and select from one of the multiple intermediaries.

38.   As to claim 35, Schiavone discloses presenting to a sender the listing of categories for the

sender to select the category therefrom [0025 – menu].

39.   As to claim 36, Schiavone discloses said negotiation module is configurable through the

user interface to either negotiate the category free of interactive input from the sender or to

receive an indication of the category from the sender through the user interface [0025 – sender

selects a specifier].

40.   As to claim 43, Schiavone discloses obtaining the listing of categories includes:

        obtaining a first listing of a first plurality of categories from a first intermediary,

retrieving a second list of a second plurality of categories from a storage location maintained by

said receiver subsystem, producing the listing of categories from a union of the first listing and

the second listing [0026, 0064]. Schiavone discloses that the listing of categories is a result of

shared "knowledge of a common set of message type specifiers". The term "common set" is well

known to refer to a set of items in common between two different sets. Thus, it would have been

obvious for one of ordinary skill in the art to have reasonably inferred from Schiavone's use of

the term "common set" that the listing of categories was a result of a union of message type

specifiers provided by the sender and the third party. Additionally, Schiavone discloses the

receiver storing public preference data at the recipient's data store while the sender retrieves

categories from a trusted intermediary.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-

3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2146

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/774,877	SIMPSON, TODD
	Examiner	**Art Unit**
	DOHM CHANKONG	2152